Docket No.: SON-2987
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ryusuke Nishida et al.

Application No.: 10/551,556 Confirmation No.: 3696

Filed: October 3, 2005 Art Unit: 2625

For: EDITING APPARATUS Examiner: L. E. Wills

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an Appeal Brief under 37 C.F.R. § 41.37 appealing the Final Office Action of the Examiner dated August 28, 2009. This Brief is also in furtherance of the Notice of Appeal previously filed on December 8, 2009 along with a Request for Pre-Appeal Brief Panel Review. A Panel Decision dated February 1, 2010 allowed this matter to proceed to the Board of Patent Appeals and Interferences.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

I.	Real Party In Interest	03/02/2010 HVUONG1 00000052 100013 10551556
II	Related Appeals and Interferences	01 FC:1402 540.00 DA
III.	Status of Claims	
IV.	Status of Amendments	

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

The real party in interest for this appeal is Sony Corporation, of Tokyo, Japan. An assignment of all rights in the present application to Sony Corp., was executed by the inventor and recorded by the U.S. Patent and Trademark Office at **reel 016993, frame 0699**.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 8 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 3

2. Claims withdrawn from consideration but not canceled: none

3. Claims pending: 1-2 and 4-8

4. Claims allowed: none

5. Claims rejected: 1-2 and 4-8

C. Claims on Appeal

The claims on appeal are claims 1-2 and 4-8

IV. STATUS OF AMENDMENTS

A Non-Final Office Action rejecting claims 1-6 was mailed on March 2, 2009 and an Amendment in response to the Non-Final Action was filed on May 22, 2009 amending the rejected claims. A Final Office Action rejecting claims 1-2 and 4-6 was mailed on August 28, 2009. A Request for Reconsideration was then filed on October 21, 2009 and an Advisory Action dated August 28, 2009 maintained the grounds of rejection. Appellant then filed a Notice of Appeal and Request for Pre-Appeal Brief Panel Review on December 8, 2009. A Decision on Panel Review dated February 1, 2010 allowed the matter to proceed to the Board of Patent Appeals and Interferences.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1. An editing apparatus comprising:	Fig. 1; p. 6, line 2.
an edit list recognition unit for recognizing an edit list describing edit contents in a general-purpose data description language, the edit contents used for creating a series of video content by editing a plurality of edit material;	Fig. 1 and 3; p. 6, line 8-15, p. 8, line 12 through p. 9, line 17.
a video content creation unit for creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation unit creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information;	Fig. 1 and 4; p. 8, line 2-10, p. 13, line 15 through p. 16, line 10.
an editing processor for performing an editing process on the video content created by the video content creation unit; and	Fig. 1 and 4; p. 14, line 8 through p. 16, line 10.
an edit list creation unit for creating a new edit list described in the general-purpose data description language based on the editing	Fig. 1;p. 6, line 8-15, p. 20, line 21 through p. 21, line 3.

process executed by the editing processor.	

Claim 2. The editing apparatus according to claim 1, wherein	Fig. 1; p. 6, line 2.
the edit list recognition unit recognizes the edit list describing effect information and meta data information as contents of the editing process.	Fig. 1; p. 6, line 21 through p. 7, line 12.

Claim 4. The editing apparatus according to claim 1, wherein	Fig. 1; p. 6, line 2.
the edit list recognition unit recognizes the edit list described in an XML (eXtensible Markup Language) as the general-purpose data description language.	Fig. 1; p. 6, line 8-15.

Claim 5. The editing apparatus according to claim 4, wherein	Fig. 1; p. 6, line 2.
the edit list recognition unit recognizes the edit list described in an SMIL (Synchronized Multimedia Integration language) in which the XML is specialized for video data and audio	Fig. 1; p. 6, line 8 through p. 7, line 12.

data.	

Claim 6. An editing method comprising:	Fig. 1; p. 6, line 2.
an edit list recognition step of recognizing an edit list in which edit contents are described in a general-purpose data description language, the edit contents used for creating a series of video content by editing a plurality of edit material;	Fig. 1 and 3; p. 6, line 8-15, p. 8, line 12 through p. 9, line 17.
a video content creation step of creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation step creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information;	Fig. 1 and 4; p. 8, line 2-10, p. 13, line 15 through p. 16, line 10.
an editing processing step of performing the editing process on the video content created in the video content creation step; and	Fig. 1 and 4; p. 14, line 8 through p. 16, line 10.
an edit list creation step of creating a new edit	Fig. 1;p. 6, line 8-15, p. 20, line 21 through p.

list described in the general-purpose data description language based on the editing process executed in the editing processing step.	21, line 3.

Claim 7. The editing apparatus according to claim 1, wherein	Fig. 1; p. 6, line 2.
said plurality of edit point information indicates IN-points and OUT-points of said edit list.	Fig. 1; p. 6, line 21 through p. 7, line 12.

Claim 8. The editing apparatus according to claim 6, wherein	Fig. 1; p. 6, line 2.
said plurality of edit point information indicates IN-points and OUT-points of said edit list.	Fig. 1; p. 6, line 21 through p. 7, line 12.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether the Examiner erred in rejecting claims 1, 2 and 6 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara et al (U.S. Patent Pub. No. 2003/0026592, hereinafter referred to as "Kawahara '592").

B. Whether the Examiner erred in rejecting claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara '592 in view of Chakravarty et al (U.S. Patent Pub. No. 2002/0175917, hereinafter referred to as "Chakravarty '917").

VII. ARGUMENT

In the Final Office Action of August 28, 2009:

The Examiner erred in rejecting claims 1 and 2 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara '592.

The Examiner erred in rejecting claim 6 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara '592.

The Examiner erred in rejecting claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara '592 in view of Chakravarty '917.

For at least the following reasons, Appellant submits that these rejections are both technically and legally unsound and should therefore be reversed.

For purposes of this Appeal Brief, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below.

A1. The Examiner erred in rejecting claims 1 and 2 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara '592.

Claim 2 is dependant on claim 1 and thus incorporate the features therein.

Claim 1 recites:

An editing apparatus comprising:

an edit list recognition unit *for recognizing an edit list describing edit contents in a general-purpose data description language, the edit contents used for creating a series of video content by editing a plurality of edit material;*

a video content creation unit *for creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation unit creates the video content by executing the*

editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information;

***an editing processor** for performing an editing process on the video content created by the video content creation unit; and*

***an edit list creation unit** for creating a new edit list described in the general-purpose data description language based on the editing process executed by the editing processor.*

Specifically, Kawahara '592 **fails** to disclose, suggest or teach "*a video content creation unit for creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation unit creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information.*"

The Office Action, however, alleges these features can be found in paragraphs [0091-0092] of Kawahara '592. This is wholly inaccurate.

Kawahara '592 relates to a content forming apparatus and method, an editing list making method, a content making apparatus and method, an editing apparatus and method and an editing information making apparatus and method, used for forming a content in a predetermined format from multiple video and/or audio materials. Specifically, Kawahara '592 discloses a means for providing an edit decision list making method of making an edit decision list permitted to form a content with low image deterioration and supporting multiple image data formats with the capability of switching processes from one to another. Kawahara '592 also discloses an edit decision list including identification information for identification of a material for use in editing, and a format declare statement for defining a format of at least a certain material.

Paragraphs [0091-0092] of Kawahara '592 state:

> [0091] The editing terminals 15, 16 and 17 form together the essential part of the EPL maker 10. They read out the highly compressed sub materials from an internal recording medium and decode them, and display, on a monitor, a video reconstructed from the decoded material data. More specifically, the operator control the sub-material server 14 via any one of the editing terminals to effect a desired operation (playback, rewind or fast forward, etc.) while visually checking a video displayed on the monitor, thus making an EPL. The EPL includes identification information for identifying editing materials, and a format declare statement for defining a format of at least a certain material. It should be noted that the format declare statement specifies, in detail, a time taken for capture of one frame, shutter speed for capturing, effective pixel number, etc. The EPL including such a format declare statement will be described in detail later.
>
> [0092] The EPL formed by each of the editing terminals 15, 16 and 17 is stored into an EPL storage unit 18. The EPL stored in this EPL storage unit 18 is read out by the edit controller 20 which will produce an edit control signal based on the EPL and supply it to the content maker 30.

Essentially, paragraphs [0091-0092] Kawahara '592 disclose a means for making an EPL. An operator controls the sub-material server via one of the editing terminals to effect a desired operation while visually checking a video displayed on the monitor, thus making an EPL. The EPL is then read out by the edit controller and supplied to the content maker.

In contrast, Appellant's invention can execute editing processes based on various kinds of editing process information described in a versatile edit list and a new edit list can be created according to the editing process, so that a more advanced editing process can be executed regardless of the type of editing apparatus, thus making it possible to realize an editing apparatus capable of executing a more advanced editing process which can be executed by all editing apparatuses, regardless of the type of editing apparatus.

Appellant's specification at p. 13, line 9 through p.14, line 24 more precisely describe the claimed features of a video content creation unit such that converts all the video data and the audio data into a prescribed edit format suitable for execution of the editing process:

> [0059] In a case where the video data VD10 to VD12 and the audio data AD10 and AD11 are created in different video formats and audio formats, the control unit 10 cannot perform an editing process in real time because of very heavy processing

loads if it decodes data in the different formats and executes the editing process.

[0060] Therefore, the control unit 10 converts all the video data VD10 to VD12 and the audio data AD10 and AD11 into a prescribed edit format suitable for execution of the editing process and then execute the editing process, resulting in performing the editing process in real time.

[0061] Specifically, at step SP8, the control unit 10 converts the video data VD10, VD11 and VD12 into the edit format suitable for editing processes of the nonlinear editing apparatus 3A to create video data NVD10, NVD11 and NVD12 for nonlinear editing (FIG. 9), and extracts desired video parts of the video data NVD10, NVD11 and NVD12 for nonlinear editing based on the edit point information of the SMIL file SF10 and stores them in the hard disk drive 14 as video clips NVC10, NVC11, and NVC12 for nonlinear editing.

[0062] In addition, the control unit 10 converts the audio data AD10 and AD11 into the edit format suitable for editing processes of the nonlinear editing apparatus 3A to create audio data NAD10 and NAD11 for nonlinear editing, and extracts desired audio parts of the audio data NAD10 and NAD11 for nonlinear editing based on the edit point information of the SMIL file SF10 and stores them in the hard disk drive 14 as audio clips NAC10 and NAC11 for nonlinear editing, and then moves on to step SP9.

(Appellant's specification at p. 13, line 9 through p.14, line 24.)

Though, Kawahara '592 reads out the highly compressed sub materials from an internal recording medium and decode them, and display, on a monitor, a video reconstructed from the decoded material data, there is ***no mention*** of a video content creation unit that creates video content by executing an editing process ***after*** converting the plurality of edit material into a prescribed edit format suitable for the editing process ***and*** extracting desired video content of the plurality of edit material based on a plurality of edit point information.

The Advisory Action alleges that the format declare statement for defining a format of at least a certain material is equivalent to converting the plurality of edit material into a prescribed edit format suitable for the editing process. However, it is noted that Kawahara '592 discloses that a format declare statement specifies, in detail, a time taken for capture of one frame, shutter speed for capturing, effective pixel number, etc. Clearly, the format declare statement does not convert the plurality of edit material into a prescribed edit format.

Indeed, the characterization within the Office Action and the Advisory Action of the claim language appears to recast the express language found within the claims by redefining the invention in a manner different that from what is set forth within the claims.

Because Kawahara '592 fails to disclose, teach or suggest various features of claim 1, a *prima facie* anticipation rejection has not been established, and reversal of this rejection is respectfully requested. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). *See also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989). ("The identical invention must be shown in as complete detail as is contained in the ... claim.").

A2. The Examiner erred in rejecting claim 6 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara '592.

Claim 6 recites:

> *An editing method comprising:*
>
> ***an edit list recognition step*** *of recognizing an edit list in which edit contents are described in a general-purpose data description language, the edit contents used for creating a series of video content by editing a plurality of edit material;*
>
> ***a video content creation step*** *of creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation step creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information;*

an editing processing step *of performing the editing process on the video content created in the video content creation step; and*

an edit list creation step *of creating a new edit list described in the general-purpose data description language based on the editing process executed in the editing processing step.*

As previously discussed, Kawahara '592 discloses a means for providing an edit decision list making method of making an edit decision list permitted to form a content with low image deterioration and supporting multiple image data formats with the capability of switching processes from one to another. Kawahara '592 also discloses an edit decision list including identification information for identification of a material for use in editing, and a format declare statement for defining a format of at least a certain material.

There is ***no mention*** of a video content creation unit that creates video content by executing an editing process ***after*** converting the plurality of edit material into a prescribed edit format suitable for the editing process ***and*** extracting desired video content of the plurality of edit material based on a plurality of edit point information in Kawahara '592.

As discussed above in further detail in the preceding section, Kawahara '592 discloses how a format declare statement specifies, in detail, a time taken for capture of one frame, shutter speed for capturing, effective pixel number, etc. Clearly, the format declare statement does not convert the plurality of edit material into a prescribed edit format.

Again, the characterization within the Office Action and the Advisory Action of the claim language appears to recast the express language found within the claims by redefining the invention in a manner different that from what is set forth within the claims.

B1. The Examiner erred in rejecting claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara '592 in view of Chakravarty '917.

Claims 4 and 5 depend from and thus incorporate the features of claim 1, which is neither disclosed nor suggested by Kawahara '592, for the reasons stated above.

Chakravarty '917 does not remedy the deficiencies of Kawahara '592, as the various features recited above are also absent from Chakravarty '917. For example, Appellant's claimed features of "*a video content creation unit for creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation unit creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information,*" are neither disclosed nor suggested by Chakravarty '917.

Chakravarty '917 concerns computer-implemented or computer-enabled methods for creating, viewing, saving and editing, or storyboarding digital assets. Digital assets that may be storyboarded include, by way of example, digital video, digital audio, etc.

As discussed above, Appellant's invention can execute editing processes based on various kinds of editing process information described in a versatile edit list and a new edit list can be created according to the editing process, so that a more advanced editing process can be executed regardless of the type of editing apparatus, thus making it possible to realize an editing apparatus capable of executing a more advanced editing process which can be executed by all editing apparatuses, regardless of the type of editing apparatus.

There is ***no mention*** of a video content creation unit that creates video content by executing an editing process ***after*** converting the plurality of edit material into a prescribed edit format suitable for the editing process ***and*** extracting desired video content of the plurality of edit material based on a plurality of edit point information in Chakravarty '917.

Because Chakravarty '917 fails to disclose, teach or suggest various features of claim 1, a *prima facie* anticipation rejection has not been established, and reversal of this rejection is respectfully requested. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,

631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). *See also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989). ("The identical invention must be shown in as complete detail as is contained in the ... claim.").

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132, or additional evidence entered by or relied upon by the Examiner is being submitted.

X. RELATED PROCEEDINGS

No related proceedings are referenced in section II above, or copies of decisions in related proceedings are not provided.

APPENDIX A

1. An editing apparatus comprising:

an edit list recognition unit for recognizing an edit list describing edit contents in a general-purpose data description language, the edit contents used for creating a series of video content by editing a plurality of edit material;

a video content creation unit for creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation unit creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information;

an editing processor for performing an editing process on the video content created by the video content creation unit; and

an edit list creation unit for creating a new edit list described in the general-purpose data description language based on the editing process executed by the editing processor.

2. The editing apparatus according to claim 1, wherein

the edit list recognition unit recognizes the edit list describing effect information and meta data information as contents of the editing process.

3. (Canceled)

4. The editing apparatus according to claim 1, wherein

the edit list recognition unit recognizes the edit list described in an XML (eXtensible Markup Language) as the general-purpose data description language.

5. The editing apparatus according to claim 4, wherein

the edit list recognition unit recognizes the edit list described in an SMIL (Synchronized Multimedia Integration language) in which the XML is specialized for video data and audio data.

6. An editing method comprising:

an edit list recognition step of recognizing an edit list in which edit contents are described in a general-purpose data description language, the edit contents used for creating a series of video content by editing a plurality of edit material;

a video content creation step of creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation step creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information;

an editing processing step of performing the editing process on the video content created in the video content creation step; and

an edit list creation step of creating a new edit list described in the general-purpose data description language based on the editing process executed in the editing processing step.

7. The editing apparatus according to claim 1, wherein

said plurality of edit point information indicates IN-points and OUT-points of said edit list.

8. The editing apparatus according to claim 6, wherein

said plurality of edit point information indicates IN-points and OUT-points of said edit list.

APPENDIX B

There is no other evidence which will directly affect or have a bearing on the Board's decision in this appeal.

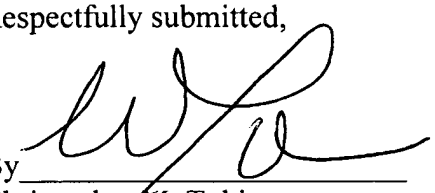
APPENDIX C

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal. There are no other court proceedings which will or have a bearing on the court's decision.

Appellant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-2987 from which the undersigned is authorized to draw.

Dated: March 1, 2010

Respectfully submitted,



By_____
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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/551,556

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APPENDIX B

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.